

DETAILED ACTION

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-23, 39, 40, 43-46, 50, 68-71, 75, 198-211, 217 and 218 rejected under 35 U.S.C. 102(e) as being anticipated by Fano (U.S. Patent 6,317,718).

Fano disclose a method for providing offers of a good, a service or information, utilizing an electronic communications device, between an offeror and a user of the electronic communication device (for example a PDA, see abstract), comprising the steps of:

Establishing communication via the electronic communications device between the offeror and user (for example communication is established between potential sellers and the user/buyer/shopper when it provides the user/buyer/shopper information about merchandise which the user/buyer/shopper has expressed interest in, see abstract);

Obtaining primary transaction data related to the primary transaction , the primary transaction data including user identity and user geographic descriptor data, (for example username and password are disclosed in column 31 lines 1+ for providing identity data and a user's "persona locations" which relate to different contexts, such as work, home or vacation (cabin) addresses which include zip codes disclosed for example in column 30 lines 22+. Examiner is construing the location addresses as geographic descriptor data);

Using the identity of the user to determine at least one additional data element, related to the user where the element is an electronic identifier for e-commerce (Such as the unique identifier disclosed in column 31 lines 4 to electronically identify a user and their "Personas" which relate to the rules related to items the user is interested in purchasing. Such as what type of airline ticket. If it is work related then certain rules apply, such as business or first class, but if personal then coach with non-refundable fares are preferred generally, see column 30 lines 22+):

Using the geographic descriptor of the user and the further data element to select among multiple items available for the geographic descriptor to determine an offer for a good, service or information; and offering the item to the user (for example the user identified by their username, password and unique identifier would be provided available flights that meet their specifications be it based on Home or Work);

(Regarding wireless and phone) where the device is a wireless phone (a PDA is a wireless phone, PDA disclosed in abstract);

(Regarding contact of user) where the offeror system contacts the user via the electronic communications device (for example see figures 26 and 27);

(Regarding negative decision criteria) Determination of an offer is subject to negative decision criteria (for example, the user does not have to purchase offers made via the system. The Persona also includes negative decision criteria, for example when all airline tickets other than United are eliminated relating to Work as the buyer wants United flights, see column 30 lines 60+);

(Regarding visual offer) where the offer is made visually to the user (see visual display in Figure 27);

(Regarding purchase item information, claim 68) Where the primary transaction data includes data representing a specific good, specific service or geographic descriptor of the user (For example, the item the user/buyer/shopper is interested in purchasing, for example, be it a good at a mall, an airline flight or a restaurant, see abstract, column 26 line 64+ and column 31 lines 22+); and

(Regarding data used to select item to present, claim 217) Where the geographic descriptor, further data element and the identity of the user is used to select among multiple items available (For example the system uses the user's ID, Persona, and data relating to the good/service/information desired and also current location, to select among available items to only present items meeting the criteria based on this data. For example only provides airline ticket options that meet the required criteria based on this data, such as only presenting an airline ticket on United that is business class when the buyer is under the Work persona.).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Kolls (US Patent 6,389,337).

Fano discloses the claimed method but is silent regarding the offer comprising a coupon (claim 36), and the offer being made orally to the user (claim 42). Kolls teaches that it is known in the art of e-commerce to use a wireless phone (312) to offer a coupon (see Abstract line 13), where the offer is made orally to the user (via element 124) to provide an audible incentives for customers to accept the offers (for example customers that do not own PDA's but have cell phones). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of providing offers of Fano with the offering of coupons orally as taught by Kolls, in order to provide an audible incentive for customers to accept offer. This is particularly advantageous for customers who have cell phones and not PDAs.

Claims 47-49, 212, 213, 215, 216, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano.

As to claims 47-49, Fano shows all elements of the claims except the particular method of obtaining the geographic descriptor information. However, the examiner notes that the subject matter of claims 47-49 are obvious variants of the methods of obtaining the geographic descriptor data recited in claims 45 or 46. It would have been an obvious matter of design choice to use any of the methods recited in claims 47-49 since it is not disclosed that the particular method of obtaining the data solves any particular problem or is for a particular purpose, and it appears that the method would function equally well with either method.

It is noted that if it determined that the claimed subject matter is not merely an obvious variant, a species requirement would be necessary.

As to claims 47, 212, 213, 215, 216, and 219, Fano fails to show utilizing data representing the identify of the user (e.g., a phone number via ANI) to obtain data representing the geographic position of the user.

Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing ANI data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been 'obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with wireless ANI data as taught by Malackowski et al, because utilizing a wireless phone extends the geographic range of communication between the user and the advertiser.

Regarding claims 48 and 49, Fano fails to expressly disclose a user or an operator manually entering geographic information.

The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an Operator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with manually entered location data as is well known in the art, because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

Response to Arguments

5. Applicant's arguments with respect to claims 21, 68 and 217 have been considered but are rejected as explained above. Examiner construes the unique identifier discussed in Fano column 31 line 4 to be the claimed electronic identifier for electronic commerce.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571/272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/
Primary Examiner, Art Unit 3627

December 3, 2007